

REJECTION UNDER 35 U.S.C. § 112

Claims 1-8 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

Notwithstanding, the applicant has amended claim 1, line 7, to remove the term "second" to more clearly recite the features of the present invention. The amendment to claim 1 is equivalent in scope of the originally filed claim and, thus, is not a narrowing amendment.

In light of the above amendment, Applicant respectfully asserts that claim 1 is in condition for allowance. Likewise, claims 2-8, which depend from claim 1, are believed to be allowable. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. 112, second paragraph, is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1-5, 7-13, 15-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa, U.S. Patent 4,498,433 in view of Jones et al., U.S. Patent Application Publication, US 2002/014827. This rejection is respectfully traversed.

The Applicant asserts that the present invention and U.S. Patent Application Publication, US 2002/014827, were, at the time the inventions were made, subject to an obligation of assignment to the same organization as prescribed in 35 U.S.C. 103(c). Enclosed, are copies of the assignments of the present invention (simultaneously being filed in the Assignment Branch) and U.S. Patent Application Publication, US 2002/014827. As such, since A) proper evidence has been filed to show common ownership at the time the invention was made, B) the reference only qualifies as prior art under 35 U.S.C. 102(e), and C) the reference was used in an obviousness rejection under 35 U.S.C. 103(a), U.S. Patent Application Publication, US 2002/014827, is removed as a reference.¹

Applicant respectfully notes that with the removal of the U.S. Patent Application Publication, US 2002/014827 as a reference, the Examiner has not met the burden of proof in showing a prima facie case of obviousness because, as the

¹ Though the Assignments are not dated concurrently, they reflect an obligation to assign to the Assignee that was common at the time of invention.

examiner has acknowledged, for example, that Ogawa “fails to show an adhesive as an attaching and sealing means in lieu of the gasket”. Therefore, Examiner’s rejection under 35 U.S.C. 103(a) is rendered moot and the applicant respectfully requests that the rejection be withdrawn.

Nonetheless, without conceding the validity of any potential rejections, Applicant hereby submits a conditional Terminal Disclaimer to be used only if the Examiner determines that the present invention should be subjected to an obviousness type double patenting rejection in view of U.S. Patent Application Publication, US 2002/014827.

In light of the assignment of the present invention and of U.S. Patent Application Publication, US 2002/014827, Applicant respectfully asserts that claims 1 and 9 are in condition for allowance. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. 103(a) is respectfully requested.

Likewise, claims 2-5, 7-8, and 10-13, 15-17, which depend from claims 1 and 9 respectively, are believed to be allowable.

The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

Further, by the present amendment, it does not follow that the amended claim has become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

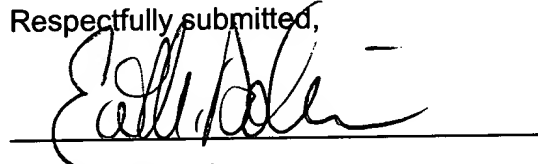
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 04-1512 for any fee which may be due.

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Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

1. (Amended) An oil pan assembly, comprising:

- a) an engine component having an associated first mating surface;
- b) a molded plastic oil pan having an associated second mating surface; and
- c) an adhesive in contact with said first mating surface and said second mating surface for joining said first component and said [second] oil pan to define an oil pan assembly, wherein the resulting joint has a strength greater than the strength of said molded plastic oil pan.

18. (New) The assembly of claim 1, wherein said oil pan is a blend of a polyamide and a syndiotactic polystyrene, and said joint is substantially free of a sealing gasket, and substantially the entirety of said first and second mating surfaces in contact with said adhesive is capable of bonding thereto.

19. (New) The assembly of claim 1, wherein said adhesive is a cure-on-demand adhesive.

20. (New) The assembly of claim 1, further comprising a plasma coating on said oil pan.

21. (New) The assembly of claim 9, wherein said oil pan is injection molded filled plastic blends of nylon and syndiotactic polystyrene, and said joint is continuous between said first mating surface and said second mating surface, and substantially the entirety of said first and second mating surfaces in contact with said adhesive is capable of bonding thereto.

22. (New) An oil pan assembly, comprising:
- a) an engine component having an associated first mating surface and one or more cutout portions;
 - b) a molded plastic oil pan having an associated second mating surface and one or more clips, wherein said one or more clips align the molded plastic oil pan with the engine component when engaged with the one or more cutout portions of the engine component; and
 - c) an adhesive in contact with said first mating surface and said second mating surface for joining said first component and said oil pan to define an oil pan assembly, wherein the resulting joint has a strength greater than the strength of said molded plastic oil pan.